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NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION			FOX, BRYAN J	
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MERRIFIELD, VA 22116			PAPER NUMBER	

2686

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/707,804

Applicant(s)

HUANG, YI-HSIANG

Examiner

Bryan J. Fox

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

*land*

Claims ~~xxx~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Kraft (US006424829B1).

Regarding **claim 1**, Kraft discloses a system where a terminal receives a short message (see column 5, lines 30-62 and figure 3), which reads on the claimed, "method of filtering messages received on a receiving telephone apparatus, the method comprising: receiving a message from a calling telephone." Then, the terminal identifies the message by reading identification means in the message and compares the identification means with parameters specified in a folder. If the folder identifies the identification means in the message, the message will be placed/stored in the folder (see column 5, lines 30-62 and figure 3), which reads on the claimed, "applying a filtering rule to the message on the receiving phone; and executing a filtering process if the message satisfies the filtering rules."

Regarding **claim 11**, Kraft discloses the short messages may be SMS messages (see column 3, lines 46-51), which reads on the claimed, "the message is a Short Message Service message."

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Wroblewski (US 20030003964A1).

Regarding **claim 3**, Kraft fails to disclose filtering the message if the telephone number of the calling telephone is not listed in a phone book of the receiving telephone apparatus.

In a similar field of endeavor, Wroblewski discloses a system where a filter process may admit incoming messages on the basis of the presence, in a header of such message, of a source indicia that matches in some way, an entry within a phone-book record (see paragraph 52), which reads on the claimed, "filtering the message if

the telephone number of the calling telephone is not listed in a phone book of the receiving telephone apparatus.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Wroblewski to include the above filtering of messages that do not match an entry in the phone book in order to maximize user convenience by eliminating undesired messages.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Ala-Luukko (US006920332B2).

Regarding **claim 4**, Kraft fails to disclose filtering the message if the telephone number of the calling telephone is listed as an entry in a blocking list stored in the receiving telephone apparatus.

In a similar field of endeavor, Ala-Luukko discloses a system where a blocking list is used to prevent SMS messages from being sent to a user (see column 7, lines 17-37), which reads on the claimed, “filtering the message if the telephone number of the calling telephone is listed as an entry in a blocking list stored in the receiving telephone apparatus.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Ala-Luukko to include the above use of a blocking list in order to maximize user convenience by eliminating undesired messages.

Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Ala-Luukko and further in view of Huna et al (US 20010012286A1).

Regarding **claim 2**, Kraft fails to disclose filtering the message if the telephone number of the calling telephone contains less than a predetermined number of digits.

In a similar field of endeavor, Ala-Luukko discloses a system where a blocking list is used to prevent SMS messages from being set to a user (see column 7, lines 17-37).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Ala-Luukko to include the above use of a blocking list in order to maximize user convenience by eliminating undesired messages. The combination of Kraft and Ala-Luukko fails to disclose the use of a wildcard in filtering messages.

In a similar field of endeavor, Huna et al disclose a system where a user could specify a filter to select only those messages originating in a certain area code (see paragraph 75).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Ala-Luukko with Huna et al to include the above use of a certain area code in order to maximize user convenience by eliminating undesired messages. The resultant combination reads on the claimed, "filtering the message if the telephone number of the calling telephone contains less than a predetermined number of digits," wherein if the numbers filtered out at the

beginning are null or zeros, and the rest are wildcards, the resultant telephone numbers would have less than a predetermined number of digits.

Regarding **claim 5**, Kraft fails to disclose the use of a wildcard for filtering messages.

In a similar field of endeavor, Ala-Luukko discloses a system where a blocking list is used to prevent SMS messages from being set to a user (see column 7, lines 17-37).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Ala-Luukko to include the above use of a blocking list in order to maximize user convenience by eliminating undesired messages. The combination of Kraft and Ala-Luukko fails to disclose the use of a wildcard in filtering messages.

In a similar field of endeavor, Huna et al disclose a system where a user could specify a filter to select only those messages originating in a certain area code (see paragraph 75).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Ala-Luukko with Huna et al to include the above use of a certain area code in order to maximize user convenience by eliminating undesired messages.

Claims 6, 7, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Vermelle et al (US 20010049279A1).

Regarding **claim 6**, Kraft fails to disclose automatically deleting the message without informing a user of the receiving telephone apparatus.

In a similar field of endeavor, Vermelle et al disclose a system where an SMS message is deleted as soon as it is consulted (see paragraphs 44-47), which reads on the claimed, "automatically deleting the message without information a user of the receiving telephone apparatus."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Vermelle et al to include the above deleting a message after consulting in order to optimize the memory without intervention by the user of the terminal as suggested by Vermelle et al (see paragraph 47).

Regarding **claim 7**, Kraft fails to disclose automatically deleting the message after a user of the receiving telephone apparatus has finished reading the message.

In a similar field of endeavor, Vermelle et al disclose a system where an SMS message is deleted as soon as it is consulted (see paragraphs 44-47), which reads on the claimed, "automatically deleting the message after a user of the receiving telephone apparatus has finished reading the message."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Vermelle et al to include the above deleting a message after consulting in order to optimize the memory without intervention by the user of the terminal as suggested by Vermelle et al (see paragraph 47).

Regarding **claim 12**, Kraft discloses a system where a terminal receives a short message (see column 5, lines 30-62 and figure 3), which reads on the claimed, "method



of filtering messages received on a receiving telephone apparatus, the method comprising: receiving a message from a calling telephone.” Then, the terminal identifies the message by reading identification means in the message and compares the identification means with parameters specified in a folder. If the folder identifies the identification means in the message, the message will be placed/stored in the folder (see column 5, lines 30-62 and figure 3), which reads on the claimed, “applying a filtering rule to the message; and executing a filtering process if the message satisfies the filtering rules.” Kraft fails to disclose automatically deleting the message without informing a user of the receiving telephone apparatus.

In a similar field of endeavor, Vermelle et al disclose a system where an SMS message is deleted as soon as it is consulted (see paragraphs 44-47), which reads on the claimed, “automatically deleting the message without information a user of the receiving telephone apparatus.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Vermelle et al to include the above deleting a message after consulting in order to optimize the memory without intervention by the user of the terminal as suggested by Vermelle et al (see paragraph 47).

Regarding **claim 17**, Kraft fails to disclose automatically deleting the message after a user of the receiving telephone apparatus has finished reading the message.

In a similar field of endeavor, Vermelle et al disclose a system where an SMS message is deleted as soon as it is consulted (see paragraphs 44-47), which reads on

the claimed, "automatically deleting the message after a user of the receiving telephone apparatus has finished reading the message."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Vermelle et al to include the above deleting a message after consulting in order to optimize the memory without intervention by the user of the terminal as suggested by Vermelle et al (see paragraph 47).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Wendelrup (US 20020023099A1).

Regarding **claim 8**, Kraft fails to disclose saving the message to a Subscriber Identity Module card of the receiving telephone apparatus without informing a user of the receiving telephone apparatus.

In a similar field of endeavor, Wendelrup discloses a system where a user may preset a priority order of where to store information that may include a SIM card (see paragraphs 32-34), which reads on the claimed, "saving the message to a Subscriber Identity Module card of the receiving telephone apparatus without informing a user of the receiving telephone apparatus."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Wendelrup to include the above storing to a device based on user priority in order to have the advantage that the user need not be concerned with the storage requirements as suggested by Wendelrup (see paragraphs 11-12).

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Soderbacka et al (WO 99/20062).

Regarding **claim 9**, Kraft fails to disclose if a SIM card of the receiving telephone apparatus is full with messages from calling telephones, the receiving telephone apparatus automatically deletes a message that matches the filtering rule.

In a similar field of endeavor, Soderbacka et al disclose a system using a SIM card (see figure 2) where if there is no free memory available for short messages, it is checked to see if the short message is a deleting one, and, if so, a previous message is deleted according to the instructions (see page 13, lines 1-17), which reads on the claimed, "if a Subscriber Identity Module card of the receiving telephone apparatus is full with messages from calling telephones, the receiving telephone apparatus automatically deletes a message that matches the filtering rule."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Soderbacka et al to include the above deleting of messages automatically in order to prevent filling the memory and missing a more useful short message when the memory is full as suggested by Soderbacka et al (see page 1, line 30 – page 2, line 11).

Regarding **claim 10**, Kraft fails to disclose if a SIM card of the receiving telephone apparatus is full with messages from calling telephones, the receiving telephone apparatus automatically deletes an oldest message that matches the filtering rule.

In a similar field of endeavor, Soderbacka et al disclose a system using a SIM card (see figure 2) where if there is no free memory available for short messages, it is checked to see if the short message is a deleting one, and, if so, a previous message is deleted according to the instructions (see page 13, lines 1-17), which reads on the claimed, "if a Subscriber Identity Module card of the receiving telephone apparatus is full with messages from calling telephones, the receiving telephone apparatus automatically deletes an oldest message that matches the filtering rule."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft with Soderbacka et al to include the above deleting of messages automatically in order to prevent filling the memory and missing a more useful short message when the memory is full as suggested by Soderbacka et al (see page 1, line 30 – page 2, line 11).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Vermelle et al as applied to claim 12 above, and further in view of Wroblewski.

Regarding **claim 14**, the combination of Kraft and Vermelle et al fails to disclose filtering the message if the telephone number of the calling telephone is not listed in a phone book of the receiving telephone apparatus.

In a similar field of endeavor, Wroblewski discloses a system where a filter process may admit incoming messages on the basis of the presence, in a header of such message, of a source indicia that matches in some way, an entry within a phone-book record (see paragraph 52), which reads on the claimed, "filtering the message if

the telephone number of the calling telephone is not listed in a phone book of the receiving telephone apparatus.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Vermelle et al with Wroblewski to include the above filtering of messages that do not match an entry in the phone book in order to maximize user convenience by eliminating undesired messages.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Vermelle et al as applied to claim 12 above, and further in view of Ala-Luukko.

Regarding **claim 15**, the combination of Kraft and Vermelle et al fails to disclose filtering the message if the telephone number of the calling telephone is listed as an entry in a blocking list stored in the receiving telephone apparatus.

In a similar field of endeavor, Ala-Luukko discloses a system where a blocking list is used to prevent SMS messages from being sent to a user (see column 7, lines 17-37), which reads on the claimed, “filtering the message if the telephone number of the calling telephone is listed as an entry in a blocking list stored in the receiving telephone apparatus.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Vermelle et al with Ala-Luukko to include the above use of a blocking list in order to maximize user convenience by eliminating undesired messages.

Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Vermelle et al and Ala-Luukko and further in view of Huna et al.

Regarding **claim 13**, the combination of Kraft and Vermelle et al fails to disclose filtering the message if the telephone number of the calling telephone contains less than a predetermined number of digits.

In a similar field of endeavor, Ala-Luukko discloses a system where a blocking list is used to prevent SMS messages from being set to a user (see column 7, lines 17-37).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Vermelle et al with Ala-Luukko to include the above use of a blocking list in order to maximize user convenience by eliminating undesired messages. The combination of Kraft, Vermelle et al and Ala-Luukko fails to disclose the use of a wildcard in filtering messages.

In a similar field of endeavor, Huna et al disclose a system where a user could specify a filter to select only those messages originating in a certain area code (see paragraph 75).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft, Vermelle et al and Ala-Luukko with Huna et al to include the above use of a certain area code in order to maximize user convenience by eliminating undesired messages. The resultant combination reads on the claimed, "filtering the message if the telephone number of the calling telephone contains less than a predetermined number of digits," wherein if the numbers filtered out

at the beginning are null or zeros, and the rest are wildcards, the resultant telephone numbers would have less than a predetermined number of digits.

Regarding **claim 16**, the combination of Kraft and Vermelle et al fails to disclose the use of a wildcard for filtering messages.

In a similar field of endeavor, Ala-Luukko discloses a system where a blocking list is used to prevent SMS messages from being set to a user (see column 7, lines 17-37).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Vermelle et al with Ala-Luukko to include the above use of a blocking list in order to maximize user convenience by eliminating undesired messages. The combination of Kraft, Vermelle et al and Ala-Luukko fails to disclose the use of a wildcard in filtering messages.

In a similar field of endeavor, Huna et al disclose a system where a user could specify a filter to select only those messages originating in a certain area code (see paragraph 75).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft, Vermelle et al and Ala-Luukko with Huna et al to include the above use of a certain area code in order to maximize user convenience by eliminating undesired messages.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Vermelle et al as applied to claim 12 above, and further in view of Wendelrup.

Regarding **claim 18**, Kraft fails to disclose saving the message to a Subscriber Identity Module card of the receiving telephone apparatus without informing a user of the receiving telephone apparatus.

In a similar field of endeavor, Wendelrup discloses a system where a user may preset a priority order of where to store information that may include a SIM card (see paragraphs 32-34), which reads on the claimed, "saving the message to a Subscriber Identity Module card of the receiving telephone apparatus without informing a user of the receiving telephone apparatus."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Vermelle et al with Wendelrup to include the above storing to a device based on user priority in order to have the advantage that the user need not be concerned with the storage requirements as suggested by Wendelrup (see paragraphs 11-12).

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Vermelle et al as applied to claim 12 above, and further in view of Soderbacka et al.

Regarding **claim 19**, the combination of Kraft and Vermelle et al fails to disclose if a SIM card of the receiving telephone apparatus is full with messages from calling telephones, the receiving telephone apparatus automatically deletes a message that matches the filtering rule.



In a similar field of endeavor, Soderbacka et al disclose a system using a SIM card (see figure 2) where if there is no free memory available for short messages, it is checked to see if the short message is a deleting one, and, if so, a previous message is deleted according to the instructions (see page 13, lines 1-17), which reads on the claimed, "if a Subscriber Identity Module card of the receiving telephone apparatus is full with messages from calling telephones, the receiving telephone apparatus automatically deletes a message that matches the filtering rule."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Vermelle et al with Soderbacka et al to include the above deleting of messages automatically in order to prevent filling the memory and missing a more useful short message when the memory is full as suggested by Soderbacka et al (see page 1, line 30 – page 2, line 11).

Regarding **claim 20**, the combination of Kraft and Vermelle et al fails to disclose if a SIM card of the receiving telephone apparatus is full with messages from calling telephones, the receiving telephone apparatus automatically deletes an oldest message that matches the filtering rule.

In a similar field of endeavor, Soderbacka et al disclose a system using a SIM card (see figure 2) where if there is no free memory available for short messages, it is checked to see if the short message is a deleting one, and, if so, a previous message is deleted according to the instructions (see page 13, lines 1-17), which reads on the claimed, "if a Subscriber Identity Module card of the receiving telephone apparatus is

full with messages from calling telephones, the receiving telephone apparatus automatically deletes an oldest message that matches the filtering rule.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Vermelle et al with Soderbacka et al to include the above deleting of messages automatically in order to prevent filling the memory and missing a more useful short message when the memory is full as suggested by Soderbacka et al (see page 1, line 30 – page 2, line 11).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bryan Fox  
August 29, 2005

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